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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/823,215	04/12/2004	David S. Rathbun	8932-890-999	1597
20583	7590	07/25/2006	[REDACTED]	EXAMINER
JONES DAY 222 EAST 41ST ST NEW YORK, NY 10017				COMSTOCK, DAVID C
			[REDACTED]	ART UNIT
				PAPER NUMBER
				3733

DATE MAILED: 07/25/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	10/823,215	RATHBUN ET AL.
	Examiner	Art Unit
	David Comstock	3733

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 04 May 2006.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-44,46-48 and 56-63 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) 37-44 and 46-48 is/are allowed.
- 6) Claim(s) 1-6,13-24,31-36,56 and 57 is/are rejected.
- 7) Claim(s) 7-12,25-30 and 58-63 is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 19 August 2004 is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____. |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>04 May 2006</u> . | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____. |

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-4, 13-15, 17 and 18 are rejected under 35 U.S.C. 102(b) as being anticipated by Brace et al. (6,342,057; cited by applicant).

Brace et al. disclose a drill guide 100 comprising a guide barrel, e.g. 136, joined to an alignment assembly 138 (see Figs. 1 and 2). The guide barrel has a bore and the alignment assembly comprises a plurality of resilient fingers 206 having a ridge at the distal end thereof for locking to a bone plate 254 having screw holes and a recess 252 (see Fig. 12). A handle 112, 114 is associated with the guide barrel and is rotatable with respect to the guide barrel in a first plane either taken through the handle and the barrel (i.e. movement or actuation of the handle members 112, 114) or taken perpendicularly to the axis of the barrel bore (i.e. rotation of the entire device about the axis of the barrel bore). The device includes a swivel assembly (e.g. 124, 158) having a locked and unlocked position. Any of the openings of the assembly such as the slot for portion 158 can be considered a drain hole. The location post is axially fixed to the alignment assembly.

Claims 1, 5, 6, 13, 14, 56 and 57 are rejected under 35 U.S.C. 102(b) as being anticipated by Brace et al. (6,342,057; cited by applicant). (Note: this rejection differs from the rejection under 35 USC 102(b) over Brace et al. that was already applied above in the interpretation of the alignment assembly.)

Brace et al. disclose a drill guide 100 comprising a guide barrel, e.g. 136, joined to an alignment assembly (see Figs. 1, 2 and 7). The guide barrel has a bore and the alignment assembly includes a location post 138 slidably received within an axial bore of a housing 206 (see Fig. 7). The location post has an extended and retracted position relative to the housing. The end of the guide barrel can be considered a depth stop since it is a surface that is capable of preventing a corresponding tool from passing therebeyond. A handle 112, 114 is associated with the guide barrel and is rotatable with respect to the guide barrel in a first plane either taken through the handle and the barrel (i.e. movement or actuation of the handle members 112, 114) or taken perpendicular to the axis of the barrel bore (i.e. rotation of the entire device about the axis of the barrel bore). The device includes a swivel assembly (e.g. 124, 158) having a locked and unlocked position. Any of the openings of the assembly such as the slot for portion 158 can be considered a drain hole.

Claim Rejections - 35 USC § 102/103

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 and 103, respectively, that form the basis for the rejections under this section made in this Office action:

Art Unit: 3733

35 USC 102(b): A person shall be entitled to a patent unless the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

35 USC 103(a): A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 19-24, 31-33, 35 and 36 are rejected under 35 U.S.C. 102(b) as anticipated by or, alternatively, under 35 U.S.C. 103(a) as unpatentable over Brace et al. (6,342,057; cited by applicant).

Brace et al. disclose the claimed invention, as set forth above, including a guide barrel 136 that appears to be clearly longer than an alignment assembly 138, 206 (see Figures 6 and 7). It is noted that the examiner is *not* attempting to deduce any particular or absolute length or proportion (e.g. "the barrel is x inches long, based on a measurement of the drawing..."); but rather, the examiner merely relies on the plain, manifest relative size of the barrel 136 vis-à-vis the alignment assembly 138, 206.¹ In addition, Brace et al. suggest the desirability of increasing the length of the barrel in order to accommodate the depth of the tissue at the surgical opening and avoid harming the surrounding tissue as well as to limit the depth to which a drill could be inserted (see col. 11, lines 48-64). Thus, even if the barrel were somehow actually not longer than the alignment assembly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have provided a longer barrel, as suggested

¹ Though perhaps a minor point, it is also noted that whatever length the barrel appears to have in figures 6 and 7, the actual length is approximately 2-8% longer since the barrels are positioned at an oblique angle, while the figures are a direct side view (cf. figures 2, 6, 7 and 17; see col. 11, lines 39-41; and note that the actual length of each barrel is the apparent length in figures 6 and 7 multiplied by $1/\cos(\theta)$, where θ is preferably 10.5° but as great as 22°).

by Brace et al., in order to accommodate the depth of the tissue at the surgical opening and avoid harming the surrounding tissue as well as to limit the depth to which a drill could be inserted. It is noted that the description of the article pictured can be relied on, in combination with the drawings, for what they would reasonably teach one of ordinary skill in the art. *In re Wright*, 569 F.2d 1124, 193 USPQ 332 (CCPA 1977).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for the obviousness rejections under this section of the Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 16 and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brace et al. (6,342,057; cited by applicant).

Brace et al. disclose the claimed invention except for explicitly disclosing the device comprising a non-metallic bearing. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the device with a bearing of a known material other than metal, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

Allowable Subject Matter

Claims 37-44 and 46-48 are allowable.

Claims 7-12, 25-30 and 58-63 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

Applicant's arguments filed 04 May 2006 have been fully considered but they are not persuasive.

Brace et al. satisfies the limitation that "the guide barrel is not pivotable relative to the alignment assembly," since the device of Brace et al. may be locked at a particular angle (see col. 12, lines 37-39). Thus, the device is capable of not being able to pivot when locked.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Comstock whose telephone number is (571) 272-4710. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



D. Comstock



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